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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/690,705      | 10/17/2000  | Joseph R. Hedrick    | 0112300/136         | 3251             |

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EXAMINER

HANSEN, JAMES ORVILLE

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3637

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/690,705

Applicant(s)

HEDRICK ET AL.

Examiner

James O. Hansen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-12,14-22 and 33-46 is/are pending in the application.
- 4a) Of the above claim(s) 14-22 and 33-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-12 and 38-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 24, 2003 has been entered.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-12 & 38-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKay et al., [U.S. Patent No. 5,813,914] in view of Drabczyk [U.S. Patent No. 5,335,605]. McKay (figures 1-21) teaches of a gaming device (10) comprising: a component cabinet (40 e.g.); a display cabinet (20 e.g.) removably connected to the component cabinet; a display device (28) including in the display cabinet and operable with a processor (74 e.g.) and a at least one player input device (32) to enable a player to play a game upon a wager by the player; and side panels (52 & 4) removably connected to opposite sides of the component cabinet and the display cabinet respectively. McKay teaches applicant's inventive claimed concept as structurally disclosed above, including a door (8) pivotally connected to the component

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cabinet, a monitor cover including a frame (48) with at least one mask (46 e.g.,) connected to the frame, a bill acceptor (36), coin acceptor (34), coin hopper (38) etc., and a locking mechanism (58, 62) removably connecting the cabinets together; but McKay does not specifically state that the side panels include a substrate with a decorative layer. However, Drabczyk (figures 1-5) teaches of a panel having a decorative laminate applied directly to a metal substrate. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the panels of McKay so as to employ a decorative layer as taught by Drabczyk because this arrangement would enhance the aesthetic appeal of the cabinets while affording flexibility in the decor of the space in which the device is situated. As to the type of substrate utilized, it would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the panels out of an aluminum material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. As to the type of laminate [sheet or sheets form], administrative notice is taken of the fact that a laminate may be applied to a substrate as a sheet or as a plurality of sheets. Fossier Jr., et al., [U.S. Patent No. 5,244,267] is cited as an evidence reference to show that the use of a sheet or sheets of laminate when applied to a substrate is old and well known. Additionally, administrative notice is taken of the fact that an adhesive may be used to bond a laminate to a substrate. Osen [U.S. Patent No. 6,053,585] is cited as an evidence reference to show that the use of adhesive to bond a laminate to a substrate is old and well known. As to the type of material utilized in the construction of the cabinets, it would have been obvious to one having ordinary skill in the art at the time the invention was made to

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manufacture the cabinets out of rolled steel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. As to the differently sized display cabinets, administrative notice is taken of the fact that differently sized cabinets may be used to form a modular cabinet structure. Krause et al., [U.S. Patent No. 6,267,462] is cited as an evidence reference to show that the use of employing differently sized cabinets to form a modular cabinet structure is old and well known. As to the multiple masks being employed, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize multiples of an existing component, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

#### ***Response to Arguments***

4. Applicant's arguments filed November 24, 2003 have been fully considered but they are not persuasive.

5. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is viewed that Drabczyk clearly teaches the concept of providing a decorative laminate directly to a metal substrate, thereby permitting a furniture structure to be designed in various

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colors and patterns for an attractive look, allow the structure to be easily altered accordingly to different color needs and ensure that the structure is easily repairable [note col., 1 of Drabczyk]; accordingly, one of ordinary skill in the art would deem obvious to modify the paneled furniture structure so as to incorporate this well known decorative panel feature.

6. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The knowledge to incorporate decorative panels on an item of furniture was previously known. The prior art clearly teaches that panels used on an item of furniture may be designed using varying indicia [color schemes or patterns] so as to promote an attractive appearance while enabling the furniture to be easily altered depending upon the user's personal preferences or aesthetic needs.

7. In response to applicant's argument that the examiner did not set forth the motivation of the combining of the prior art, note the following: It is viewed that the above rejection adequately sets forth the motivation of the supplemental cited art in view of the knowledge which was previously known at the time.

8. In response to applicant's argument that the display cabinet is not removably connected to the component cabinet, note the following: It is viewed that the claim only stipulates that the two cabinets are removably connected to each other i.e., the

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capability of being removed. As such, fig. 2 of McKay clearly depicts the two cabinets having the ability of being removed or detached from each other [removably connected]. Applicant may be reading more into the claim than is currently present e.g., the claim does not state that a display cabinet is positioned on top of a component cabinet, the two cabinets when attached in this manner constituting a “gaming device”, and the display cabinet may be detached from the top of the component cabinet.

9. In response to applicant’s argument that the McKay does not show the side panels as being removably connected [interpreted as the “capability of being removed”], note the following: It is viewed that the side panels are inherently removable since the cabinet is not disclosed as being an integrally molded product or formed from a single stock of material for instance, the panels are clearly secured to the frame or chassis of the cabinet {note figure 17 showing the fastener locations on one side panel - furthermore, figures 9-11 show the component cabinet frame with fastener locations for securing one of its side panels} and can be removed if needed as is conventional in the cabinet art.

10. Lastly, in response to applicant’s remark concerning the “evidence references” under administrative notice, the arguments for the challenge were stipulated as “improper and based on impermissible hindsight”. As such, these arguments are viewed as being an inadequate traversal of the issue relating to the cited evidence references under administrative notice; accordingly, the limitations in question are now taken as admitted prior art.

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**Conclusion**

11. This is a continuation of applicant's earlier Application No. 09/690,705 [present application number]. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

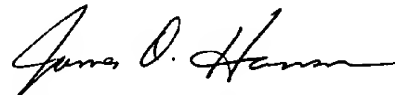
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James O. Hansen whose telephone number is 703-305-7414. The examiner can normally be reached on Mon.-Fri. 8-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



James O. Hansen  
Primary Examiner  
Art Unit 3637

JOH  
February 12, 2004